



#4 | Reg for
Rocan
1/27/99
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

✓ Applicants: Daniel M. Eggert, et al. **RECEIVED**
✓ Title: MAGNETIC BIT HOLDER AND HAND
TOOL INCORPORATING SAME **JAN 25 1999**
✓ Serial No.: 09/109,392 **Group 3700**
✓ Filing Date: July 2, 1998
Group Art Unit: 3723
Examiner: D. Meislin
Date: January 12, 1999

Assistant Commissioner for Patents
Washington, D.C. 20231

REQUEST FOR RECONSIDERATION

Sir:

In response to the Office Action dated December 12, 1998, reconsideration of the rejected claims is respectfully asked.

Claims 1-24 are rejected under 35 U.S.C. §251 as being based upon a defective reissue declaration. In support of the rejection, the examiner asserts that the reissue declaration fails to particularly specify the errors and/or how the errors relied upon arose or occurred "as required under 37 CFR 1.175(a)(5)." The rejection is respectfully traversed.

The rule section relied on by the examiner is no longer in effect and was not in effect at the time the application was filed. The current 37 CFR §1.175(a), which governs reissue oaths or declarations, took effect December 1, 1997. It does

not include a subsection (5). The section no longer requires particularly specifying the errors relied upon and how they arose or occurred. Rather, the section simply requires that applicants state "at least one error being relied upon as the basis for reissue" (§1.175(a)(1)) and provide a "general statement that the errors arose without deceptive intent" (§1.175(a)(2)). Since applicants' reissue declaration identifies at least one error as the basis for reissue (¶ 6) and make the requisite statement that the errors arose without deceptive intent (¶ 7), it is submitted that the declaration is in compliance with the applicable rule.

Claim 24 is also rejected under 35 U.S.C. §251 as being based upon new matter, on the ground that the claim language "continuous, closed, non-reentrant outer periphery" is not supported by the original disclosure. The rejection is respectfully traversed.

In assessing the "new matter" proscription in 35 U.S.C. §251, the pertinent inquiry is "whether one skilled in the art reading the specification would identify the subject matter of the new claims as invented and disclosed by the patentees." *In re Amos*, 21 USPQ2d 1271, 1275 (Fed.Cir. 1991). In this regard, the term "new matter" in 35 U.S.C. §251 has the same meaning as the same term in 35 U.S.C. §132. *In re Oda et al.*, 170 USPQ 268, 270 (n. 2) (CCPA 1971). Thus, it is appropriate to consider cases decided under either section in determining

whether or not claim 24 is based on new matter.

Claim 24 recites a retaining member having "a continuous, closed, non-entrant outer periphery." Such a retaining member (26) is clearly disclosed in Figs. 2 and 3. That member has a circular outer periphery, which constitutes a continuous, closed, non-reentrant curve. In this regard, each of the words "continuous," "closed," and "reentrant" is a common word used in its ordinary dictionary sense.

While it is true that the phrase "continuous, closed, non-reentrant outer periphery" is not found in the original specification or claims, that fact is not significant if the described structure is clearly shown in the drawings. *In re Reynolds*, 170 USPQ 94, 97 (CCPA 1971). The inclusion in later-filed claims of an explicit description of the physical structure or property of a device does not constitute new matter, even though that specific description was not present in the original disclosure, as long as the property or structure described was inherently present in the original disclosure. *Kennecott Corp. v. Kyocera International, Inc.*, 5 USPQ2d 1194, 1198 (Fed.Cir. 1987). In the Kennecott case, the court not only permitted the addition of claim language directed to a body having "equiaxed microstructure," but it further permitted the addition of photomicrographs of the body to illustrate that structure, despite the fact that the original application made no mention of equiaxed microstructure. It permitted the

additions solely on the basis of the fact that the body, as described in the original disclosure, inherently had the described equiaxed microstructure. The present application presents an even more compelling case, since there is no need to add a drawing showing the described structure, that structure already being clearly illustrated in the original drawing. Accordingly, it is submitted that claim 24 is clearly supported by the original disclosure. However, applicants have no objection to adding to the specification the questioned language from claim 24, if such an amendment is deemed useful.

Claim 24 is also rejected under 35 U.S.C. §111, first paragraph as containing subject matter "which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." This rejection appears to be on fundamentally the same basis as the "new matter" rejection discussed above. Thus, the examiner is apparently contending that the original patent does not disclose that there is any significance to the fact that the retaining member has a "continuous, closed, non-reentrant outer periphery." As was pointed by the court in *Kennecott, supra*:

"The incorporation of the requirements of section 112 into section 120 ensures that the inventor had possession of the later-claimed invention on the filing date of the earlier application." (5 USPQ2d at 1197).

In *Kennecott*, the court held that the original disclosure satisfied the requirements of §112, even though it not only made no mention of "equiaxed microstructure", but also failed to include any illustration of it. Under the criteria applied by the court in *Kennecott*, there is no question that applicants "had possession" of the invention recited in claim 24, by reason of its clear illustration in the drawing. See also *Kolmes v. World Fibers Corp.*, 41 USPQ2d 1829, 1832 (Fed. Cir. 1997).

For all of the foregoing reasons, it is respectfully submitted that claims 1-24 are based on an adequate reissue declaration and that claim 24 is not based upon new matter and is supported by a disclosure fully in accord with the first paragraph of 35 U.S.C. §112. Accordingly, reconsideration and withdrawal of the rejections of the claims and allowance of the application are respectfully asked.

Respectfully submitted,

Emrich & Dithmar
Attorneys for Assignee
Suite 3000
300 South Wacker Drive
Chicago, Illinois 60606
Telephone 312-663-9800

By

A handwritten signature in black ink, appearing to read "Jerry Stratman", is written over a horizontal line. The signature is fluid and cursive, with "Jerry" and "Stratman" being the most distinct parts.